IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:) Date: August 2, 2004

Richard D. Marry, et al.   ) Attorney Docket No.: E-954

Serial No.: 09/474,909   ) Customer No.: 00919

Filed: December 28, 1999   ) Group Art Unit: 3629

Confirmation No.: 5067   ) Examiner: Tan D. Nguyen

Title: METHOD OF CALCULATING SORTING COSTS FOR CHARGEBACK ACCOUNTING FOR AN INCOMING MAIL SORTING APPARATUS

TRANSMITTAL OF APPEAL BRIEF (PATENT APPLICATION 37 CFR 1.192)

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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{I0029201.1 }

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Respectfully submitted,

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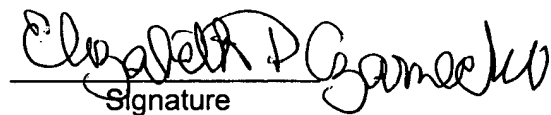P.O. Box 3000
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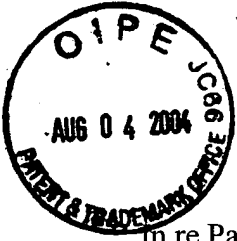P.O. Box 1450
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IN THE. UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of:)Attorney Docket No.: E-954

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ACCOUNTING FOR AN INCOMING MAIL SORTING APPARATUS

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APPELLANTS' BRIEF ON APPEAL

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 1.191 et seq. from the

final rejection of claim 13 of the above-identified application mailed January 23, 2004. The fee

for submitting this Brief is $330.00 (37 C.F.R. § 1.17(c)). Please charge Deposit Account No.

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No. **16-1885**. Enclosed with this original are two copies of this brief.

{I0029118.1 }

REAL PARTY IN INTEREST

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences known to Appellants, their legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

STATUS OF CLAIMS

The instant application was filed with claims 1-6. In the Amendment dated March 10, 2003, claims 4-6 were canceled. Pursuant to the Final Office Action dated March 2, 2004, claims 1-3 stand rejected under 35 USC §103 as being obvious in view of Article 7/1998 (the "1998 Article") in view of Article 8/1995 (the "1995 Article").

STATUS OF AMENDMENTS

The are no pending amendment to the claims filed subsequent to the final rejection dated January 22, 2004. Therefore, the claims as set forth in Appendix A to this brief are those as set after the final rejection.

SUMMARY OF INVENTION

Various automated mail handling machines have been developed for processing incoming mail (removing individual pieces of mail from a stack and performing subsequent actions on each individual piece of mail). Generally, the mail handling machines separate individual mailpieces from a stack, read the mailpieces using an optical character recognition system (OCR) and compare the read information to an addressee database in order to determine the appropriate destination points for delivery of the mailpieces. These mail handling machines do not include functionality that would track the numbers and types of mailpieces that are sorted for each of the departments (e.g., addressees) of the company for which the mail is being sorted, and calculate a charge back amount for accounting of mailroom expenses.

Thus, one of the problems of the prior art is that a system is not available for calculating charge back costs for incoming mail sorting. Another problem of the prior art is that expense allocation can be imprecise. Yet another problem of the prior art is that incoming mail handling machines do not provide detailed information for charge back accounting. Therefore, a method that calculates charge back cost of incoming mail sorting is needed.

The present claimed invention overcomes the disadvantages, or more preciously, deficiencies, of prior art incoming sortation systems by providing a method of calculating sorting costs for incoming mailpieces attributable to the addressees of incoming mailpieces. The foregoing is accomplished by providing a method that can determine the number and types of mailpieces for each of the addresses being sorted in an incoming sorter and storing that information in a database. The combination of the number and types of mailpieces being sorted for an addressee can then be used to calculate a charge back amount for that addressee by using a predetermined cost per mailpiece based upon the type of mailpiece. Thus, the present invention is directed to a method of calculating sorting costs for addresses having mailpieces sorted in an incoming mail sorting apparatus based upon the number of mailpieces sorted as well as the type of mailpieces that were sorted. For instance, it is more costly to sort large flats as compared to postcards and the more mailpieces that are sorted will also incrementally add to the addressees sorting costs.

A primary advantage of the method of the present invention is that it provides a method of calculating charge back costs to addressees for incoming mail sorting, which prior art systems and methods for sorting mailpieces were unable to do.

ISSUES

The sole issue on appeal is whether the subject matter defined in claims 1-3 is rendered obvious by the 1998 Article in view of the 1995 Article.

GROUPING OF CLAIMS

Claims 1-3 are grouped together, thus they stand or fall together.

ARGUMENT

As Appellant discusses in detail below, the final rejection of claims 1-3 are devoid of any factual or legal premise that supports the position of unpatentability. It is respectfully submitted that the rejection does not even meet the threshold burden of presenting a prima facie case of unpatentability. For this reason alone, Appellants are entitled to grant of a patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A.   The subject matter defined in claims 17-22, 24-29, 31 and 32 is not rendered obvious by the '583 patent in view of the '810 patent, in further view of the '844 patent.

In formulating this argument, reference is made to claim 1, which recites "A method of calculating sorting costs for an incoming mail sorting apparatus . . " including the steps of, inter alia:

> d)   storing a piece count for each one of the plurality of mailpieces sorted using the incoming mail sorting apparatus, the piece count stored in association with corresponding addressee information from the database of addressees and said determined type of mailpiece in the incoming mail sorting apparatus; and

> e)   calculating incoming sorting cost information using the piece count stored in association with the corresponding addressee.

Thus a piece count corresponding to the number of mailpieces sorted for a particular addressee is stored along with the type of mailpieces that were sorted in that piece count for a particular addressee. This sorted information is then used for calculating a sorting cost attributable to that

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particular addressee, which is used for charge back purposes. For instance, suppose a first addressee has 200 mailpieces sorted in the incoming sorting apparatus wherein 150 of them are flats and the other 50 are postcards. It's attributable sorting costs will be different than that compared to a second addressee who had 400 mailpieces sorted in the incoming sorting apparatus wherein 300 of them were flats and the remaining 50 were postcards. Thus, this present invention method is greatly advantageous in allocating the sorting cost for each addressee that uses a common incoming sorting apparatus so as to provide tailored charge back costs to each addressee that uses the sorter for its incoming mailpieces.

With respect to the 1998 and 1995 Articles, it is submitted neither of them teach nor suggest this claimed feature of the present invention. With specific reference to the '1998 article, the examiner admits it does not "calculat[e] the sorting cost information using the piece count stored in association with the corresponding addressee (steps (d) and (e))." In this regard, the examiner applies the '1995 article since it arguably "teach[es] about automation of mail pieces with OCR sorting apparatus whereby sorting costs of mailpieces are calculated ($3.00/1000 letters using OCR system of the Postal Service Computer Equipment) and each OCR contains a data base for every delivery address in the nation for computing and correction of the information." However, this recitation from the '1995 article, and all the teachings of the '1995 article for that matter, fail to teach or suggest of attributing sorting costs to specific addressees having mailpieces processed in a common incoming sorting apparatus. This is because both the '1995 and '1998 articles are directed towards the advantages of using automated sorting systems in the U.S Postal distribution centers as opposed to more manual sorting processes. And clearly one of the advantages would be the cost savings realized by the U.S. Postal Service. This is evident in the '1995 article which states that with OCR automated sorting equipment, the cost for sorting 1000 letters is $3.00.

However, when taken under the context of the present invention, both the '1995 and '1998 articles are clearly unconcerned with the claimed steps (d) and (e) of claim 1 of the present invention method. The '1995 and '1998 articles have no reason to be concerned with allocating sorting costs to individual addressees because these articles concern the virtues of using automated sortation in U.S. Postal distribution centers for all mailpieces being processed and would have no reason to provide a suggestion or teaching of allocating U.S Postal sorting costs to

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individual addressees based upon the number and type of mailpieces. And apart from using hindsight, doing so would just make no sense with U.S. Postal sorting equipment since this processing fee for the mailpieces is already paid for by the mailers via postage fees, thus why would the U.S. Postal Service be interested in charge backs for the addressee of the mailpieces? Thus, "calculating incoming sorting cost information using the piece count stored in association with [a] corresponding addressee" is clearly neither taught nor suggested by the combination of the '1995 article with the '1998 article.

Accordingly, it is submitted that Claims 1-3 are allowable over the '1995 article in combination with the '1998 article and that this rejection be removed.

IX.   CONCLUSION

In Conclusion, Appellants respectfully submit that the final rejection of claims 1-3 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,

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APPENDIX A

Claim 1. A method of calculating sorting costs for an incoming mail sorting apparatus having a database of addressees for use in sorting incoming mailpieces comprising the steps of:

a)   collecting information about each one of a plurality of mailpieces sorted using the incoming mail sorting apparatus, the information used to determine a type of mailpiece and a type of addressee information for each one of the plurality of mailpieces;

b)   determining the type of mailpiece using the information collected in step a);

c)   associating the information about each one of the plurality of mailpieces sorted using the incoming mail sorting apparatus with addressee information from the database of addressees;

d)   storing a piece count for each one of the plurality of mailpieces sorted using the incoming mail sorting apparatus, the piece count stored in association with corresponding addressee information from the database of addressees and said determined type of mailpiece in the incoming mail sorting apparatus; and

e)   calculating incoming sorting cost information using the piece count stored in association with the corresponding addressee.

Claim 2. The method as claimed in claim 1 wherein the information about each one of the plurality of mailpieces comprises a type of mailpiece selected from the group consisting of: a letter, a flat and a postcard.

Claim 3. The method as claimed in claim 1 wherein the information about each one of the plurality of mailpieces comprises a type of addressee information selected from the group consisting of: hand print, hand script, interoffice and interoffice form.